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In the Supreme Court of the United States

OCTOBER TERM, 1963.

No. 505.

COMMITTEE APPOINTED BY THE COURT OF COMMON PLEAS OF FRANKLIN COUNTY, OHIO,

Petitioner,

vs.

BATTELLE MEMORIAL INSTITUTE,

Respondent.

REPLY BRIEF IN BEHALF OF PETITIONER.

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November 29, 1963.

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THE PETITION IS NOT A REQUEST FOR AN ADVISORY OPINION.

Respondent states, at page 4 of its Brief, that "Ohio, in the exercise of its control, has determined that practice before an administrative body or agency is not the practice of law," and in support of such statement cites *Goodman, et al. vs. Beall, et al.*, 130 Ohio State 427, 200 N. E. 470 (1936), and *Public Service Traffic Bureau vs. Haworth Marble Co.*, 40 O. App. 374, 178 N. E. 703 (1931).

In the *Goodman* case, the Court held that the preparation of the record before the Bureau of Workmen's Compensation (an administrative agency) constituted the practice of law, in the following language:

> "Such record constitutes the entire evidence upon which the merits or demerits of a claim can be determined by a Court and jury. If a record be poorly and inexpertly prepared, the rights of interested parties may be seriously prejudiced. Its formation unquestionably comes within a well considered and complete definition of the practice of law."

Public Service Traffic Bureau, Inc. vs. Haworth Marble Co., 40 O. App. 255; 178 N. E. 703, was a suit to enforce a contract in which the defense contended that the contract was void for the reason that it contemplated the practice of law by a corporation. Plaintiff agreed to audit the freight bills of the Defendant and to prepare, file, prosecute and adjust in the name of the Defendant all claims developed on the freight bills. Respondent herein, at page 4, states: "Specific reference was made therein to patent practice." The only reference to patent matters was the following statement by the Court:

> "Practice before the Commissioner of Patents is not confined to attorneys-at-law."

The *Public Service* case turned upon the meaning of "to prosecute" claims, as stated in the contract, and it was held that the Order of the Interstate Commerce Commission is not a cause of action on a judgment on which an execution may issue. It was further held that the obtaining of "recoveries," as stated in the contract, means activities which are not confined to securing awards from the Interstate Commerce Commission but to institute proceedings before a Court of justice. Thus, the *Pubic Service* case is not authority for the assertion that the acts of Respondent do not constitute the practice of law in Ohio.

A recent decision by the Supreme Court of Ohio holding that practice before an administrative agency constitutes the practice of law in Ohio is *In re Brown Weiss & Wohl*, 175 Ohio State 149 (July 15, 1963). The opinion by the Court of Common Pleas of Cuyahoga County, Ohio, in such case is reported at 92 O. L. A. 257 (decided June 29, 1962).

To the same effect is *In re Bailey*, 73 O. L. A. 343, affirmed in 73 O. L. A. 347. In that case an actuary was

enjoined from prosecuting claims before the Ohio Bureau of Unemployment Compensation and before the Board of Review, notwithstanding the fact that the Bureau permits the filing of claims by non-lawyers.

In *Marshall vs. New Inventors Club*, 69 O. L. A. 578, 117 N. E. (2nd) 737 (1953), the Court held that the preparation of patent applications constitutes the practice of law in Ohio. The Defendant in that case was a corporation and was engaged in precisely the same activity as the Respondent in this case.

Based upon the aforesaid assertion of Respondent that practice before an administrative agency is not the practice of law in Ohio, Respondent concludes that "even if this case were to be reversed and remanded the judgment would be the same," citing *Herb vs. Pitcairn*, 324 U. S. 17, 65 S. Ct. 459, 89 L. Ed. 789, and quoting an excerpt therefrom which states that this Court is not permitted to render an advisory opinion.

The Petition herein is not a request for an advisory opinion because:

A. The Court of Appeals did not disturb the finding of the Court of Common Pleas that the acts of Respondent constitute the unauthorized practice of law in Ohio. Thus, it cannot be said that a remand of the case would result in a finding in favor of Respondent. The presumption is that the Appellate Court would follow the cases heretofore cited in support of the Petition.

B. The Court of Appeals believed that it was precluded from carrying out the law in Ohio, on the ground that the Federal Government has pre-empted the field as to patent matters and that, therefore, the State Court lacks jurisdiction to consider and decide any question of un-

authorized practice of law pertaining to patent matters. Therefore, if the Petition is decided favorably to Petitioner and the case is remanded, the Courts of Ohio would take jurisdiction and the Supreme Court of Ohio would then be free to follow the law of Ohio, as expressed by the Court of Common Pleas, that the acts of Respondent under Ohio law constitute the unauthorized practice of law.

Respondent in support of its contention that the Petition is only a request for an advisory opinion asserts (at pages 5 and 6 of the brief) that the Ohio Court of Appeals *found* that the action was not "a proper one brought by proper parties." Such assertion refers to the two alternative procedures suggested by the Court of Appeals, one being a new suit by "quo warranto" proceedings and the other by a new suit based on "ultra vires." The only *finding* by the Court of Appeals was that there was no jurisdiction because of the Federal question. (Pet. Brief, p. 48a.)

The alternative procedures suggested by the Court of Appeals were admitted to be "obiter dicta," because as to them, the Court stated (Pet. Brief, p. 52A):

> "We point out the foregoing not to state what can or should be done or to here determine in advance the validity of such proceedings since to do so would be obiter dicta * * *."

Respondent has performed acts in connection with patent matters other than the preparation and prosecution of Applications for Patents.

Respondent states, at page 6 of its Brief, that there is no evidence of drafting legal documents and giving legal advice to Sponsors of Respondent. Opinions to Sponsors on questions of infringement of issued patents may be found in Court Committee Exhibits 1, 2 and 5 and in the Transcript at pages 38, 60, 65, 66 and 69.

Additionally Respondent prepares assignments (Transcript page 118), agency agreements (Transcript page 109, and Courts Committee Exhibit 7, Invoice A-5573), and license agreements (Transcript pages 110 to 113 and Court Committee Exhibit 7, Invoices A-5834, A-7126, A-7365, A-7366, A-7814, A-8829 and A-9125). Respondent has engaged in the drafting and negotiating of contracts (Transcript page 113 and Court Committee Exhibit 7, Invoice A-9444 and A-11763) and has rendered legal opinions to Sponsors concerning the effect of foreign laws and treaties on patents (Court Committee Exhibit 5 and Transcript pages 74, 74-a, 75, 76, 76-a, 77 and 78).

Many of the foregoing exhibits were mentioned by the Court of Common Pleas (Petitioner's Appendix pages 10-a and 11-a) as evidence to support its findings that Respondent has performed the acts alleged in the Court Committee application filed November 16, 1957, and that such acts "have been an unauthorized practice of the law, that the same should be restrained, and that the Battelle should be enjoined from so engaging in the unauthorized practice of law" (Appendix to Petition page 15-a).

For the reasons stated it is respectfully submitted that the petition should be granted.

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